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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,812	02/04/2002	Richard J. Greff	1001.2216102	8436
28075 7590 08/18/2010 CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420				
EXAMINER				
GHALL, ISIS A D				
ART UNIT		PAPER NUMBER		
1611				
MAIL DATE		DELIVERY MODE		
08/18/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/068,812

Applicant(s)

GREFF, RICHARD J.

Examiner

Isis A. Ghali

Art Unit

1611

—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 03 August 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Isis A Ghali/
Primary Examiner, Art Unit 1611

Continuation of 11. does NOT place the application in condition for allowance because:

Claims 22-25, 27-30, 32, 33, 42 remain rejected under 35 U.S.C. 102(b) as being anticipated by Pawelchak et al. (US 4,292,972, IDS filed 03/06/2003).

Claim 26 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Pawelchak et al. in view of JP 02-182259 ('259).

Claim 31 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Pawelchak in view of EP 5568 334 ('334).

Applicant argues that nowhere does Pawelchak teaches or suggests: "wherein the wetting agent is coated on at least a substantial portion of the surface of the preformed gelatin sponge by soaking the preformed gelatin sponge in a coating solution including the wetting agent and the non-aqueous solvent", as recited in independent claim 22. Instead, Pawelchak appears to teach foaming a composition which includes a surface tension modifier, such that the surface tension modifier is dispersed throughout the gelatin whether before or after cross-linking. Pawelchak teaches Tween 60 and the related compounds are said to be added to enhance the quality of the foam produced by foaming the composition thus indicating that the composition is not yet cross-linked when the surface tension modifier is added prior to foaming. Further, the composition at that stage is aqueous and does not appear to include a non-aqueous solvent. The Examiner appears to be asserting that the composition is anticipated because it contains similar components without properly taking into account that the materials of Pawelchak are not arranged as required by the claim. Applicants argue that Pawelchak teaches freeze dried composition. Applicants argue that Tween 60, cited Pawelchak, causes premature foam collapse when incorporated directly into the foaming composition under conditions taught by the pending application; however when coated onto the surface of a preformed sponge, deposition from a non-aqueous solvent does not significantly collapse the preformed and crosslinked foam and provides the benefit of reducing hydration time from 6 minutes to 24-35 seconds.

In response to this argument, it is argued that it is argued that the reference clearly discloses method of making the foam by forming dispersion containing aerated foamed gelatin, which reads on preformed, and adding the surfactant and glycerin to the dispersion read on non-aqueous solvent and wetting agent added to the gelatin composition, followed by drying of the dispersion and forming a sponge product (col.4, lines 40-47, 60-68; col.5, lines 1-2). Adding the surfactant and/or glycerin to the dispersion containing foamed aerated gelatin meet the limitation of coating the gelatin with the wetting agent by soaking as instantly claimed by claim 22 because applicants coated the gelatin foam by soaking the foam in the wetting agent. In any event, the present claims are directed to composition and all the elements of he composition are taught by the prior art. The limitation of "coating the gelatin sponge by soaking in" is directed to method of making the composition that does not impart patentability to composition claims. The present claims recite evaporating the solvent and this means the final product does not include the solvent. The present product is gelatin sponge and wetting agent substantially coated on the sponge as taught by the reference. The present claims are considered by "product by process claim", and product by process claims are not limited to the manipulation of the recited steps, only the structure implied by the steps. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by- process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698,227 USPQ 964, 966 (Fed. Cir. 1985), wherein the product-by- process claim was rejected because the end product, in both the prior art and the claimed product were the same. The structure implied by the process steps should be considered when assessing the patentability of product-by- process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., In re Gamero, 412 F.2d 276,279, 162 USPQ 221,223 (CCPA 1979). Since the claimed product appears to be substantially identical to that of the prior art, the burden is shifted to applicant to show an unobvious difference between the claimed product and the prior art product and to come forward with evidence establishing an unobvious difference. The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature than when a product is claimed in the conventional fashion. In re Fessmann, 489 F.2d 742,744, 180 USPQ 324,326 (CCPA 1974); In re Marosi, 710 F.2d 798,802,218 USPQ 289, 292 (Fed. Cir.1983); Exparte Gray, 10 USPQ2d 1922 (Bd. Pat. App. & Inter. 1989). It has been held that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by- process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." In re Brown, 459 F.2d 531,535, 173 USPQ 685, 688 (CCPA 1972). The reference process provided gelatin sponge coated with wetting agent as instantly claimed. The present claims' language does not exclude the step of freeze drying taught by the reference. The present specification disclosed drying, and the present claims does not exclude freeze drying. The examiner does not understand the argument that "the freezing and drying steps of Pawelchak are necessary to form the foam sponge, and thus the wetting agent is not coated (as a coating solution including the wetting agent and a non-aqueous solvent) on at least a substantial portion of the surface of a preformed gelatin sponge".

Applicant argues that Yasushi and Song do not remedy the shortcomings of Pawelchak. In response to this argument, it is argued that Yasushi is relied upon for the solely teaching of specific wetting agents as claimed by claim 26 and Song is relied upon for the solely teaching of inclusion of growth factor in wound dressing as claimed by claim 31.